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**Patent and Trademark Office**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/686,546    10/11/00    COVATCH

C    10294-539001

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QM12/0913

EXAMINER

STASHICK, A

ART UNIT

PAPER NUMBER

3728

DATE MAILED:

09/13/01

*3*

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/686,546

Applicant(s)

COVATCH, CHARLES E

Examiner

Anthony D Stashick

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "26" has been used to designate both opening and instep portion. Correction is required.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: reference number 13 in no in the Figures as recited on page 2, line 28 and page 3, line 1. Correction is required.

### *Specification*

3. The disclosure is objected to because of the following informalities: reference number 26 was defined as "opening" on page 3, line 4 then later referred to as "instep portion" on page 3, lines 6, 8, 13, 20 and 26. Reference number 56 was defined as "hollow channels" on page 4, line 1 then later referred to as "air-filled channels" on page 4, line 4, "cross pieces" on page 4, line 6, and "curved members" on page 4, line 8. Adherence to one descriptive term for reference number should be followed. Also, reference number 58 was defined as "hollow channel" on page 4, line 1 then later referred to as "air-filled chamber" on page 4, line 7. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Claims 4 and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

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invention. Claims 4 and 16 both recite the limitation "the plurality of holes" in the first line of each claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 13-14, 16-19, 21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Crowley 5,701,688. Crowley '688 discloses all the limitations of the claims including the following: an instep guard 1 for covering the metatarsals; an elastic (see col. 2, lines 51-60) support 1 having the shape and size commensurate with the instep section of the footwear (see Figures and col. 2, lines n4-64); the elastic support having a plurality of hollow passages 4; a first sheet 8; plurality of support members 4 extending from the first sheet and defining the hollow passages; hollow passages are filled with air ( see col. 2, lines 55-59); hollow passages are elongated (see col. 2, lines 51-55); cross-section of elongated passage has circular or ovoid shape (see Figure 4); elastic support includes resilient material (see col. 2, lines 51-64).

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 1-2, 4-7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crowley 5,701,688 in view of the German reference to Schabsky 1,103,811 (Schabsky '811). Crowley '688 discloses all the limitations substantially as claimed including the following: an instep guard 1 for covering the metatarsals; an elastic (see col. 2, lines 51-60) support 1 having the shape and size commensurate with the instep section of the footwear (see Figures and col. 2, lines n4-64); the elastic support having a plurality of hollow passages 4; a first sheet 8; plurality of support members 4 extending from the first sheet and defining the hollow passages; hollow passages are filled with air ( see col. 2, lines 55-59); hollow passages are elongated (see col. 2, lines 51-55); cross-section of elongated passage has circular or ovoid shape (see Figure 4); elastic support includes resilient material (see col. 2, lines 51-64); outsole 14 attached to upper to define cavity for foot. Crowley '688 does not teach the use of the metatarsal guard with a steel toe. Schabsky '811 teaches that a steel toe 1 safety boot can have a metatarsal guard (2 and 5) attached to and used in conjunction with the steel toe boot to protect the metatarsals from impact of falling objects. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a steel toe boot, such as that shown in Schabsky '811, with a metatarsal guard, such as that shown in Crowley '688, to protect the entire top area of the user's foot from any articles that may be dropped upon it.

10. Claims 3 and 8 are rejected under 35 U.S.C. 103(a) as being obvious over the references as applied to claims 1 and 2 in paragraph 9 above. The references as modified and applied to claims 1 and 2 in paragraph 9 above disclose all the limitations of the claims except for the instep guard comprising a second sheet connected to the first sheet by the support members and the elongated passages having two different cross-sections. With respect to the second sheet attached to the first by the support members, it is well know in the art of shock protection that air filled chambers, such as that used in what is typically termed "bubble wrap", can be contained between two sheets of material with the support members connecting the two sheets of material to better distribute the weight and impact force over a

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greater area. Therefore, it would have been obvious to place a second sheet of material on top of the support members and connected to the support members to better distribute the force of the impact over a greater area of the protector. With respect to the cross-section being different in different elongated passages, it appears that it would have been a mere matter of testing and optimization as well as design choice to find what particular cross-section or combination of cross-sections would give the desired cushionability and impact protection.

11. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 10 in paragraph 9 above in view of Johnsen 2,988,829. The references as modified and applied to claim 10 above disclose all the limitations of the claims except for the liner having stitching around the instep guard to attach it to the liner. Johnsen '829 teaches that a metatarsal guard can be stitched to the shoe by a stitch line 31 to prevent the guard from moving when placed within the shoe. Therefore, it would have been obvious to stitch the metatarsal guard of the references as modified and applied to claim 10 in paragraph 9 above to the upper or liner to prevent the guard from moving when placed within the shoe between the liner and the outer cover.

12. Claims 15 and 20 are rejected under 35 U.S.C. 103(a) as being obvious over Crowley 5,701,688. Crowley '688 discloses all the limitations of the claims except for the instep guard comprising a second sheet connected to the first sheet by the support members and the elongated passages having two different cross-sections. With respect to the second sheet attached to the first by the support members, it is well known in the art of shock protection that air filled chambers, such as that used in what is typically termed "bubble wrap", can be contained between two sheets of material with the support members connecting the two sheets of material to better distribute the weight and impact force over a greater area. Therefore, it would have been obvious to place a second sheet of material on top of the support members and connected to the support members of Crowley '688 to better distribute the force of the impact over a greater area of the protector. With respect to the cross-section being

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different in different elongated passages, it appears that it would have been a mere matter of testing and optimization as well as design choice to find what particular cross-section or combination of cross-sections would give the desired cushionability and impact protection.

13. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Crowley 5,701,688 in view of the German reference to Schabsky 1,103,811 (Schabsky '811). Crowley '688 discloses all the limitations of the claim except for the support being located between the instep portion of the footwear and a liner. Schabsky '811 teaches that a metatarsal protector can be placed between a liner and the outer portion of the upper in the instep region of a shoe to protect the metatarsals from impact from falling objects. Therefore, it would have been obvious to one of ordinary skill in the art to place the guard of Crowley '688 between the upper material and liner to help hold the guard within the shoe and properly place it upon the user's foot.

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure and are cited on form 892 enclosed herewith.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Tuesday through Friday from 8:30 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul T. Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9301 for regular communications and 703-872-9301 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/8335
Fee Increase Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Informal Fax for 3728	(703) 308-7769

If the information desired is not provided above, or has been changed, please do not call the examiner (this is the latest information provided to him) but the general information help line below.

Information Help line	1-800-786-9199
Internet PTO-Home Page	<a href="http://www.uspto.gov/">http://www.uspto.gov/</a>



Anthony D Stashick  
Examiner  
Art Unit 3728

ADS  
September 10, 2001



**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.